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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re application of: | Tara Chand Singhal |) | |
| Serial No: | 09/196,963 |) | |
| Filed: | November 20, 1998 |) | Art Unit |
| For: | UNIVERSAL CHARITY CARD SYSTEM |) | 2876 |
| Examiner: | St. CYR, DANIEL. |) | |
| Attorney Docket: | 11195.10 |) | |

SUPPLEMENTAL APPEAL BRIEF

Commissioner for Patents
P O Box 1450, Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R Section 1.193 (2)(ii), reinstatement of the appeal is requested. A supplemental appeal brief is being filed herein and attached herein. In his reply brief dated 05/04/204, Examiner reopened prosecution via an office action in that reply brief. In a teleconference with the examiner on 6/10/2004 no agreement was reached on the substance of his reopened prosecution office action. This is the reason for requesting reinstatement of the appeal.

This Supplemental Appeal Brief is being filed in triplicate, as required within the statutory time period, of sixty days on or before 7/4/2004

It should be noted that the Appellant is the inventor and is not a registered practioner. The Notice of Appeal was filed 6/30/03 on the Final office action dated 5/7/03.

Dated this the 17th day of June, 2004

Respectfully submitted,



Tara Chand Singhal

Appellant

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CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop: Appeal Brief, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450, on 17th June, 2004 by Tsing TARA CHAND SINGHAL, Applicant

SUPPLEMENTAL APPEAL BRIEF

Pursuant to 37 C.F.R Section 1.193 (2)(ii), reinstatement of the appeal is requested. A supplemental appeal brief is being filed herein. Examiner reopened prosecution after an appeal brief had been filed in an office action dated 5/7/04. In a teleconference with the examiner on 6/10/2004 no agreement was reached on the substance of his reopened prosecution office action. This is the reason for requesting reinstatement of the appeal.

In this supplemental Appeal Brief, only the Sections 6 and 8 are supplemented to as here. Section 9 has all the pending claims, subject of this appeal. There is no change in section 1 to 5, 7 and they are included here by reference to the Appeal.

(6) ISSUES

In the examiner's reply brief response to the appeal brief, examiner did not address the appellant's response but raised these new issues as follows:

ISSUE 1:

Examiner in his response dated 5/4/2004 has rejected claims 72-73 as being anticipated under 35 USC 102(b) by Pekka, WO 93/14476.

ISSUE 2:

Examiner in his response dated 5/4/2004 has rejected claims 45-71 and 74, under 35 USC 103(a) Obviousness Rejection as being unpatentable over Pekka, in view of Derwent application AU 676819.

ISSUE 3:

Claims 47, 53, 54, 61 and 63, as noted by the examiner in his office action of 5/4/2004 have claim informalities. Appellant thanks the examiner for noting these informalities and has made these corrections in the Section 9: Appendix that reproduces all the pending claims.

(8) ARGUMENT

Please add the following arguments to this section that address each of these new issues above.

ISSUE 1:

Examiner mis-characterizes the disclosure in Pekka in regard to this anticipated rejection of claims 72 –73 as follows:

Examiner states “ Pekka discloses a method for making and collecting donation comprising: means for giving charity cards 12 to donors, the charity cards having identification information for both the users and the charities (in order for the card to include the user, a registration must be made); a cash register 16 for collecting donation; a central computer 22 linking the cash register; the collected donation may be electronically transferred or generating a check to the charity; and the donation contribution is printed on the sale receipt. (see pages 6-9, and 15, last paragraph).”

Appellant reproduces the last paragraph on page 15 of Pekka here:

Pekka, Page 15, last paragraph, “For example, if the code in question is “011111222229”, (UPC-A), when this code is entered into the system and stored in mass storage, the code informs the software that the donation value is fixed at \$10.00, and transfers this fixed donation amount to the computer-based cash terminal. This software also extracts the additional instructions that, when this particular code is entered, the cash register should show on its display monitor the text “Donation American Cancer Society \$10.00” and later print this line of text on the donor’s receipt.”

Appellant’s Arguments:

Pekka teaches that the customer/donor is making a donation out of his own funds and relies on the merchant, as a matter of mere convenience, to collect customer’s own funds and forward the same to the charity. The merchant gives the donor a donation receipt for the donor’s donation.

It is customary for many merchants to display near their check out counters pre-configured charity cards, for amounts such as Five dollars or Ten dollars for Food for Hunger Programs etc. The donors desiring to donate pick up one or more these pre-configured charity cards from the display and present it to the checkout clerk. These cards have UPC codes, like any other merchandize, which the merchant computer systems recognize. The merchant clerk scans them into the register. The receipt, that is printed based on scanning the UPC code, shows the identification of the merchandize (name of the charity) and the merchandize price (donated amount such as Five or ten dollars).

What Pekka discloses in last paragraph of page 15 of Pekka is no different than what is described above. In Pekka , donor is making a donation out of donor's own funds that the donor tenders at the merchant checkout counter, and for which the donor gets a receipt as described above.

Claim 72 is copied here, with highlights in bold.

72. A sales receipt printed for a customer by a merchant sales terminal, wherein the sales receipt comprising: on the face of the sales receipt, identification of a charitable entity along with **an amount of contribution to the entity by the merchant.**

In contrast, claim 72, as copied above with highlight is wholly different and distinguishable from Pekka for the following reasons:

(1). The last line of claim 72 states, as highlighted in bold, "an amount of contribution to the entity by the merchant."

(2) In Pekka, the sales receipt shows a donor's donation as a merchandize line item as part of other merchandise line items that are added up to a total dollar amount on the sales receipt and which the customer pays.

In contrast, claim 72 identifies not a line item of purchase for donor's donation, but an identification of funds donated by the merchant, that are not part of sales item total. Since the language of claim 72 identified the funds as amount of contribution by the merchant, they are not and cannot be a line item on the sales receipt and are not part of sales receipt total, as in Pekka. Hence, claim 72 is wholly different than what Pekka discloses.

(3) In the current invention as claimed in claim 72, the donated funds that are listed on the receipt are merchant's funds, the amount being decided by the merchant, and not donor's funds, and the receipt is not used for claiming a tax deduction by the donor but to generate and reinforce goodwill for the merchant in helping a charity of donor's choice.

(4) Examiner stated in the tele-conference on 6/10/2004, that it is common for the merchant's to make donations to charities and so advertise to their customers to increase their goodwill and thus business. While Appellant agrees with this general assertion, appellant disagrees that Merchants indicate on the customer's sales receipt, the amount of merchant's donation for that specific sales transaction. The applicant/appellant is not aware of or has any knowledge that any merchant identifies and notes/prints on the sales receipt the particular amount of donation that is donated by the merchant and arising out of that sales transaction,. It is to be noted that application filing date of November 1998 of this application.

Hence, the donation of donor's own funds by a donor at the merchant check out, and getting a receipt for the same, as a line item of purchase, as in Pekka, is wholly different than the Merchant donating merchant's own funds to a charity of customer's choice and printing that donation amount on the sales receipt, as in claim 72.

Therefore, Appellant submits that the cited reference of Pekka does not anticipate claim 72 and dependent claim 73.

ISSUE 2:

The two items of prior art that are cited by the examiner are:

Prior Art Item (1)

Pekka, discloses, a system, where, an individual is choosing to make charitable contributions to a charity and is merely using the incident of a purchase transaction with a merchant to tender extra money than required for the purchase, intending to give the extra money as a charitable contribution and the merchant forwarding the individual's contributions to the charity, the identification of the charity being facilitated by a charity card on which the charity information is encoded and the charity card is presented to the merchant at the point of sale.

Prior Art Item (2) Derwent application AU 676819

Basic-Abstract:

The method of commerce involves causing the participating merchant to provide a rebate/discount to participating purchasers, and enabling the participating merchants to facilitate passage of the purchaser's funds to a charity or similar organization. Upon each or selected transactions between the participating merchants and participating purchasers, participating purchaser's funds to the value of the provided rebate/discount are passed to the charity as a donation from the participating purchaser.

The transactions are conducted through an electronic funds transfer network which is able to operatively access the necessary account records of the participating merchants, the participating purchaser's, a participating charity and determine the amount of rebate/discount provided by each participating merchant. The funds are donated to charity so that the donations constitute tax-deductible donations for the purchasers.

Examiner had cited Pekka earlier. Examiner has cited Derwent in his reply brief. Appellant had already provided arguments why Pekka is different then the claims 45 – 71 and 74. Here Appellant provides arguments why Derwent likewise Pekka is different

then the claims 45-71 and 74. Derwent abstract is reproduced below with two features highlighted in bold:

The method of commerce involves causing the participating merchant to provide a rebate/discount to participating purchasers, and enabling the participating merchants to facilitate passage of the purchaser's funds to a charity or similar organization. Upon each or selected transactions between the participating merchants and participating purchasers, **participating purchaser's funds to the value of the provided rebate/discount are passed to the charity as a donation from the participating purchaser.**

The transactions are conducted through an electronic funds transfer network which is able to operatively access the necessary account records of the participating merchants, the participating purchaser's, a participating charity and determine the amount of rebate/discount provided by each participating merchant. **The funds are donated to charity so that the donations constitute tax-deductible donations for the purchasers.**

Derwent clearly makes the following important disclosures:

- (1) The funds being donated are the purchaser's funds and not the merchant's funds.
- (2) Donations constitute tax-deductible donations for the purchasers.

Therefore, Appellant submits that the Derwent is no different than Pekka in its disclosure. In both of these prior arts, Pekka and Derwent, the customer/purchaser/donor's own funds are being donated to the charity and being collected by the merchant on behalf of the donor as a matter of convenience to the donor.

In the current invention, the claim group 45-52 is for a charity system facilitating contributions from a merchant to a charitable entity using means clauses. The independent claim 45 provides:

45. A charity system facilitating contributions from a merchant to a charitable entity comprising:

- a. first means for making available a charity card with encoded charity identification to a select group of public desiring to benefit the entity;
- b. second means for a merchant computer system with a sale terminal, on being presented the charity card, reading the encoded charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group;
- c. third means for aggregating the allocated contributions from a plurality of sale transactions with the select group and sending the aggregate contributions to the entity.

The claim 45 has element (b) that is not taught by Pekka and Derwent. Elements (a), (b), and (c) are not taught by the common practice of the merchants making a donation to the charities.

Specifically element (b) states that the merchant makes a contribution from the proceeds of the sales of the merchant as a percent of sales. In Pekka and Derwent, the contribution is by the customer of customer's own funds.

In view of these arguments, claim 45 is not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Appellant submits that the scope and content of prior art and the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. Therefore, the obviousness rejection fails the Graham v. Deere test.

In the current invention, the claim group 53-61 is for a charity system facilitating contributions from a merchant to a charitable entity using function clauses. The independent claim 53 provides:

53. (currently amended) A charity system facilitating contributions from a merchant to a charitable entity comprising:

- a. a first function for receiving and storing entity data of ~~[these]~~ entities willing to influence a select group of public to patronize ~~[these]~~ merchants who are willing to contribute a percent of their sales to the entities;
- b. a second function for receiving and storing data of members of select group desiring to patronize merchants willing to contribute to the entities [entity];
- c. a third function printing and mailing a charity card encoded with charity identification and member identification to the members of select group;
- d. a fourth function in a merchant computer system with a sale terminal enabling reading the charity card and computing a contribution as a percent of sale and storing said contribution data identified by entity identification and member identification into a merchant database.

This claim 53 has element (c) that is not taught by Derwent and elements (d) that is not taught by Pekka. Elements (a), (b), (c) and (d) are not taught by the common practice of the merchants making a donation to the charities.

Specifically element (c) states that the charity card is encoded with charity identification and customer identification and element (d) states that the merchant makes a contribution from the proceeds of the sales of the merchant as a percent of sales. In Pekka, the charity card is encoded with charity identification and in Pekka and Derwent, the contribution is by the customer of customer's own funds.

In view of these arguments, the claim 53 is not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Appellant submits that the scope and content of prior art

and the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. Therefore, the obviousness rejection fails the Graham v. Deere test.

In the current invention, the claim group 61-71 is for a method for facilitating contributions from a merchant to a charitable entity using steps. The independent claim 61 provides:

61. (currently amended) A method facilitating contributions from a merchant to a charitable entity comprising the steps of:
- a. making available to a select group of public desiring to benefit the entity a charity card with encoded entity identification;
 - b. receiving by ~~presenting~~ the merchant at a merchant computer system with a sale terminal the charity card by members of the select group; and
 - c. reading by the merchant sale terminal of the charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group.

This claim 61 has element (c) that is not taught by Pekka and Derwent. Elements (a), (b), and (c) are not taught by the common practice of the merchants making a donation to the charities.

Specifically element (c) states that the merchant makes a contribution from the proceeds of the sales of the merchant as a percent of sales. In Pekka and Derwent, the contribution is by the customer of customer's own funds.

In view of these arguments, the claim 61 is not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Appellant submits that the scope and content of prior art and the differences between the claims of this invention and prior art is such that an

obviousness rejection has no grounds. Therefore, the obviousness rejection fails the Graham v. Deere test.

In the current invention, the claim group 72-74 is for sales receipt from a merchant to a customer specific to those customers and merchants who are participants in the UCCS. The independent claim 72 provides:

72. A sales receipt printed for a customer by a merchant sales terminal, wherein the sales receipt comprising: on the face of the sales receipt, identification of a charitable entity along with an amount of contribution to the entity by the merchant.

This claim 72 has elements that are not taught by Pekka and are also not taught by the common practice of the merchants making a donation to the charities. Specifically, the differences between the common practice and the current invention claims 72-74 are:

- (a) In the common practice art, the merchant does not print on a sales receipt of a particular customer the funds donated to charity on behalf of that particular customer to a charity of customer's choosing as in this invention.
- (b) In the common practice, the merchant does not print on a sales receipt to a particular customer the cumulative contributions to a specific charity(s) based on sales to that customer as in this invention.

When a customer sees printed on the sales receipt the amount of money being given to a charity of his/her choice, it acts as an immediate motivating factor creating a good will for the merchant, from which the merchants benefit by building loyalty. Thus the UCCS charity card acts as a loyalty card for the merchant. The common practice is usually limited for short duration in time such as three months and does not act as a loyalty card for the merchant and therefore a UCCS is much more effective for the merchant in building goodwill in the community and increasing sales.

In view of these arguments, the claim 72 is not obvious over the cited combination of the prior art. Dependent claims are likewise not obvious over the cited combination of the prior art. Appellant submits that the scope and content of prior art and the differences between the claims of this invention and prior art is such that an obviousness rejection has no grounds. Therefore, the obviousness rejection fails the Graham v. Deere test.

Appellant submits that the scope and content of prior art as described above and the differences between the claims of this invention and prior art are such that an obviousness rejection has no grounds. Hence claims 45-71 and 74 are not obvious over the cited combination of Pekka and Derwent and do not satisfy the Graham v. Deere test for obviousness.

In view of these arguments, the claim 45-71 and 74 are not obvious over the cited combination of the prior art of Pekka and Derwent. Therefore, the obviousness rejection fails the Graham v. Deere test.

(9) APPENDIX

Claims involved in this appeal are:

45. A charity system facilitating contributions from a merchant to a charitable entity comprising:

- a. first means for making available a charity card with encoded charity identification to a select group of public desiring to benefit the entity;
- b. second means for a merchant computer system with a sale terminal, on being presented the charity card, reading the encoded charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group;
- c. third means for aggregating the allocated contributions from a plurality of sale transactions with the select group and sending the aggregate contributions to the entity.

46. The charity system as in claim 45, wherein the first means comprising:

- a. means for members of the select group registering into the charity system;
- b. means for the charity system printing the charity card identifying the entity by an encoding means and mailing the charity cards to members of the select group.

47. (currently amended) The charity system as in claim 45, wherein the first means comprising:

- a. means for registering the entity [~~registering itself~~] and members of the select group into the charity system;
- b. means for the charity system printing the charity card identifying the entity and the members of the select group by an encoding means and mailing the charity cards to the entity for distribution to the select group.

48. The charity system as in claim 45, wherein the second means comprising:
means for the merchant sale terminal printing a sales receipt identifying the entity and
the contribution to the entity from the sale transaction.

49. The charity system as in claim as in 45, wherein the second means comprising:
means for the merchant sales terminal printing a sales receipt identifying the entity, the
contribution to the entity from this sale transaction, and the cumulative contributions
from prior sales transactions.

50. The charity system as in claim 45, wherein the third means comprising:
a. means for collecting contributions from a plurality of merchants allocated to
plurality of entities;
b. means for aggregating contributions for entity and performing one electronic fund
transfer to entity bank.

51. The charity system as in claim as in 50, further comprising: means for preparing
and sending the entity an accounting statement, identifying the merchant and the
contribution from the merchant.

52. The charity system as in claim as in 50, further comprising: means for preparing
and sending to the merchant an accounting statement, identifying each of the entities
and the contribution from the merchant.

53. (currently amended) A charity system facilitating contributions from a merchant to
a charitable entity comprising:
a. a first function for receiving and storing entity data of [~~these~~] entities willing to
influence a select group of public to patronize [~~these~~] merchants who are willing to
contribute a percent of their sales to the entities;
b. a second function for receiving and storing data of members of select group
desiring to patronize merchants willing to contribute to the entities [~~entity~~];

- c. a third function printing and mailing a charity card encoded with charity identification and member identification to the members of select group;
- d. a fourth function in a merchant computer system with a sale terminal enabling reading the charity card and computing a contribution as a percent of sale and storing said contribution data identified by entity identification and member identification into a merchant database.

54. (currently amended) The charity system as in claim 53, further comprising:

- a. a fifth function reading the merchant databases from a plurality of merchants and aggregating the contributions to the entity by the merchants;
- b. a sixth function performing a fund transfer of aggregate contributions from the merchants to the entities [entity].

55. The charity system as in claim 53, wherein the second function comprising: receiving and storing a plurality of charitable entity identifications and percent split of contributions between the plurality of charitable entities.

56. The charity system as in claim 55, wherein the charity card additionally encoded with a plurality of entity identifications along with the percent split of contributions.

57. The charity system as in claim 56, wherein the fourth function comprising: splitting the contribution among the plurality of entities and storing said contribution data in the merchant database.

58. The charity system as in claim 57, wherein the fourth function comprising: a sub-function that prints on a sales receipt the entities and the contributions to the entities from the sale transaction.

59. The charity system as in claim 53, wherein the fourth function comprising: a sub-function that prints on a sales receipt the entity and the contribution to the entity from the sale transaction.

60. The charity system as in claim 53, wherein the fourth function comprising:
a sub-function that prints on a sales receipt the contribution to the entity from this sale transaction and cumulative contribution from prior sales transactions.

61. (currently amended) A method facilitating contributions from a merchant to a charitable entity comprising the steps of:

- a. making available to a select group of public desiring to benefit the entity a charity card with encoded entity identification;
- b. receiving by [~~presenting~~] the merchant at a merchant computer system with a sale terminal the charity card by members of the select group; and
- c. reading by the merchant sale terminal of the charity card, computing a contribution by multiplying a sale amount and a percent of sale and allocating the contribution to the entity, wherein the merchant will contribute to the entity the percent of sales of the merchant to the select group.

62. The method as in claim 61, comprising the step of:
aggregating by the merchant the allocated contributions from a plurality of sale transactions and sending the contributions to the entity.

63. (currently amended) The method as in claim 61, comprising the steps of:

- a. registering by the entity [~~of itself~~] and members of the select group into a universal charity card system;
- b. printing by the system, the card identifying the entity and the members of the select group by an encoding means and mailing the charity cards to the entity for distribution to the select group.

64. The method as in claim 63, comprising the step of:

printing by the system, the charity card identifying the entity and a member of the select group by an encoding means and mailing the charity cards to the members of the select group.

65. The method as in claim 61 comprising the steps of:

- a. registering by the entity itself into a universal charity card system; and
- b. notifying by the entity of the select group to obtain from the system the charity card identifying the entity and a member of the select group.

66. The method as in claim 61, comprising steps of:

- a. collecting contributions by the system from a plurality of merchants allocated to plurality of entities;
- b. aggregating by the system contributions for the entity and performing one fund transfer to an entity bank.

67. The method as in claim 66, comprising the step of: preparing and sending by the system to the entity an accounting statement, identifying the merchant and the contribution from the merchant.

68. The method as in claim 66, comprising the step of: preparing and sending by the system to the members of the select group of public an accounting statement identifying the charity and the contribution from the select member purchases from the merchant

69. The method as in claim 66, comprising the step of: preparing and sending by the system to the merchant an accounting statement, identifying each of the entities and the contribution from the merchant.

70. The method as in claim 61, comprising the step of: printing by the merchant sale terminal a sales receipt identifying the contribution to the entity from the sale transaction.

71. The method as in claim 61, comprising the step of: printing by the merchant sales terminal a sales receipt identifying the contribution to the entity from this sale transaction, and the cumulative contributions from prior sales transactions.

72. A sales receipt printed for a customer by a merchant sales terminal, wherein the sales receipt comprising: on the face of the sales receipt, identification of a charitable entity along with an amount of contribution to the entity by the merchant.

73. The claim as in 72, wherein the identification of a charitable entity comprising: identification of at least one charitable cause.

74. The claim as in 72, wherein the amount of contribution comprises: an amount of contribution from a present sales transaction and an amount of contribution from prior sales transactions.

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